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Stephen P. Forte

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DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN P. FORTE

Appeal 2009-001884
Application 09/879,917
Technology Center 2600

Decided: September 28, 2009

Before ROBERT E. NAPPI, MARC S. HOFF, and
ELENI MANTIS MERCADER, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the final rejection of claims 1-26 and 29.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We affirm the Examiner's rejection of these claims.

INVENTION

The invention is directed to a device and method of using a wireless device as a virtual office telephone so that features such as voice mail, corporate calling plans, and direct extension dialing may be utilized without specialized cellular equipment or handsets. *See generally* Spec. 1-4. Claim 1 is representative of the invention and reproduced below:

1. A telecommunication device comprising:
a telephony interface, said telephony interface for receiving a telephone call via a first communication path and identifying a dialed telephone number associated with the call, said telephony interface using the dialed telephone number to retrieve at least one wireless telephone number and at least one user preference from a storage medium, said telephony interface using said at least one retrieved user preference to route the call to at least two wireless destination telephone numbers substantially simultaneously via respective second and third communication paths, and said telephony interface connecting the call to a user by connecting said first communication path to the second or third communication path when the second or third communication path is authenticated by the user,
wherein said dialed telephone number and at least one of said at least two wireless destination telephone numbers are associated with an enterprise telecommunication network consisting solely of wireless devices and wherein the other of said at least two wireless destination telephone numbers is

¹ Claims 27-28 were cancelled in an Amendment filed August 30, 2006.

not associated with the enterprise telecommunication network.

REFERENCES

Karpus	US 5,884,191	Mar. 16, 1999
Hartmaier	US 5,978,672	Nov. 2, 1999
Jackson	US 6,275,577 B1	Aug. 14, 2001 (filed Aug. 21, 1998)
Cox	US 2002/0013141 A1	Jan. 31, 2002 (filed Oct. 3, 2001 ²)
Chow	US 6,711,401 B1	Mar. 23, 2004 (filed Dec. 13, 1999)
LaPierre	US 6,771,761 B1	Aug. 3, 2004 (filed Dec. 29, 1999)

REJECTIONS AT ISSUE

The Examiner rejected claims 1-3,³ 5, 8, 10-13, 15-18, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Hartmaier in view of Jackson and LaPierre. Ans. 3-6.

The Examiner rejected claims 4, 6, 7, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Hartmaier in view of Jackson, LaPierre, and Chow. Ans. 8-11.

² Effective filing date: Apr. 28, 1994.

³ Claim 3 was inadvertently left out of the statement of rejection by the Examiner. However, the rejection of this claim is found on page 6 of the Examiner's Answer.

The Examiner rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Hartmaier in view of Jackson, LaPierre, and Cox. Ans. 11.

The Examiner rejected claims 19-23, 25, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Hartmaier in view of Jackson, LaPierre, and Karpus. Ans. 12-16.

The Examiner rejected claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Hartmaier in view of Jackson, LaPierre, Karpus, and Chow. Ans. 16-17.

ISSUES

Rejection of claims 1-3, 5, 8, 10-13, 15-18, and 26 under 35 U.S.C. § 103(a) as unpatentable over Hartmaier in view of Jackson and LaPierre

Claims 1-3, 5, 8, 10-13, and 15-18

Appellant argues on pages 14-17 of the Appeal Brief and pages 3-4 of the Reply Brief that the Examiner's rejection of claims 1-3, 5, 8, 10-13, and 15-18 is in error. We select independent claim 1 as representative of the group comprising claims 1-3, 5, 8, 10-13, and 15-18 since Appellant does not separately argue any of the claims with particularity. 37 C.F.R. § 41.37(c)(1)(vii). Appellant argues that Hartmaier, Jackson, and LaPierre do not teach the claim limitations of claim 1.

Thus, with respect to claims 1-3, 5, 8, 10-13, and 15-18, Appellant's contentions present us with the issue: has Appellant shown that the Examiner erred in finding that Hartmaier in view of Jackson and LaPierre teaches the claim limitations set forth in claim 1?

Claim 26

Appellant argues on pages 17-18 of the Appeal Brief and pages 3-4 of the Reply Brief that the Examiner's rejection of claim 26 is in error. Claim 26 contains similar limitations to claim 1. Appellant presents many of the same arguments discussed above with respect to claim 1. App. Br. 17-18; Reply Br. 3-4. Appellant additionally argues that the Examiner improperly combined the references.

Thus, Appellant's arguments with respect to the Examiner's rejection of claim 26 presents us with the same issue as claim 1. Additionally, with respect to claim 26, Appellant's contention presents us with the additional issue: has Appellant shown that the Examiner erred in combining Hartmaier with Jackson and LaPierre?

Rejection of claims 4, 6, 7, and 14 under 35 U.S.C. § 103(a) as unpatentable over Hartmaier in view of Jackson, LaPierre, and Chow

Appellant argues on pages 18-19 of the Appeal Brief and pages 3-4 of the Reply Brief that the Examiner's rejection of claims 4, 6, 7, and 14 is in error. Claims 4, 6, 7, and 14 contain similar limitations and are dependent upon claim 1. Appellant presents many of the same arguments discussed above with respect to claim 1. App. Br. 18-19; Reply Br. 3-4. Appellant additionally argues that the combination of Chow with Hartmaier, Jackson, and LaPierre is in error. App. Br. 19.

Thus, Appellant's arguments with respect to the Examiner's rejection of claims 4, 6, 7, and 14 present us with the same issue as claim 1. Additionally, with respect to claims 4, 6, 7, and 14, Appellant's contention presents us with the additional issue: has Appellant shown that the Examiner erred in combining Chow with Hartmaier, Jackson, and LaPierre?

*Rejection of claim 9 under 35 U.S.C. § 103(a) as unpatentable over
Hartmaier in view of Jackson, LaPierre, and Cox*

Appellant argues on pages 19-20 of the Appeal Brief and pages 4-5 of the Reply Brief that the Examiner's rejection of claim 9 is in error. Claim 9 contains similar limitations and is dependent upon claim 1. Appellant presents many of the same arguments discussed above with respect to claim 1. App. Br. 19-20; Reply Br. 4-5.

Thus, Appellant's arguments with respect to the Examiner's rejection of claim 9 presents us with the same issue as claim 1.

*Rejection of claims 19-23, 25, and 29 under 35 U.S.C. § 103(a) as
unpatentable over Hartmaier in view of Jackson, LaPierre, and Karpus*

Appellant argues on pages 20-23 of the Appeal Brief and pages 4-5 of the Reply Brief that the Examiner's rejection of claims 19-23, 25, and 29 is in error. Claims 19 and 29 contain similar limitations and claims 20-23 and 25 are dependent upon claim 19. Appellant argues that Karpus does not teach "generating and sending a simulated dial tone to the wireless telephone and providing access to [an] enterprise telecommunication network . . . [that] consists solely of wireless communication devices." App. Br. 22; Reply Br. 4-5.

Thus, Appellant's arguments with respect to the Examiner's rejection of claims 19-23, 25, and 29 present us with the issue: has Appellant shown that the Examiner erred in finding that Karpus teaches generating and sending a simulated dial tone to the wireless telephone and providing access to an enterprise telecommunication network that consists solely of wireless devices?

*Rejection of claim 24 under 35 U.S.C. § 103(a) as unpatentable over
Hartmaier in view of Jackson, LaPierre, Karpus, and Chow*

Appellant argues on page 23 of the Appeal Brief and pages 4-5 of the Reply Brief that the Examiner's rejection of claim 24 is in error. Claim 24 contains similar limitations and is dependent upon claim 19. Appellant presents many of the same arguments discussed above with respect to claim 19. App. Br. 23; Reply Br. 4-5.

Thus, Appellant's arguments with respect to the Examiner's rejection of claim 24 presents us with the same issue as claim 19.

FINDINGS OF FACT

Hartmaier

1. Hartmaier discloses an interface between private data network applications and wireless network applications (WIN). Col. 8, ll. 65-67.
2. The interface allows a caller to call a particular number and not know the difference between whether the called network is wireless, private wired, or a combination of the two. In addition, resident applications such as voice mail and private dialing plans are accessible. Col. 9, ll. 1-14.
3. When a caller calls a cell or a private branch exchange (PBX) number, the call is routed, by the system, to the location where the person called is most likely to answer. Col. 12, ll. 10-23.
4. When a caller calls a private branch exchange number and the system is set for the call to be forwarded to the cell phone, the

private branch exchange (PBX) forwards the call to the cell phone.
Col. 12, ll. 24-27.

Jackson

5. Jackson discloses a method of simultaneously routing a call to one or more telephone numbers where a caller may be reached. Col. 1, ll. 7-11.
6. An incoming call is provided to a switching system that routes the call to a plurality of devices such as a wireless telephone, a pager, and an answering machine. Each of the devices has a different telephone number. Col. 2, ll. 3-12.
7. The router determines the identity of the caller and the number called and determines where the call is to be routed based on a comparison between the received information and the screening list. Col. 2, ll. 13-24.
8. When the screening requires the received call to be routed to the pager and wireless phone, the router simultaneously routes the call to both devices so that the call is available for connection immediately by either. Col. 2, ll. 25-28.
9. Subsequently, the user can choose to answer or connect to the call by pushing the “call” or “on” key on the wireless phone. Col. 2, ll. 31-36.

LaPierre

10. LaPierre discloses a system that provides call routing to multiple telephone numbers or devices via a single telephone number. Col. 1, ll. 7-10.

11. A subscriber registers alternate destinations with a universal number. When a caller calls the universal number the caller is given an option to connect to any of the registered devices or lines. Col. 1, l. 65-col. 2, l. 3.
12. The available devices to connect to include: landlines, cellular telephones, wireless telephones, fax machines, modems, and other similar devices. Col. 2, ll. 3-6, col. 3, ll. 42-47.

Karpus

13. Karpus discloses “an interface system for connecting various accessory devices to a radiotelephone.” Col. 1, ll. 56-58.
14. Wireless communication links connect the interface device to all of the other devices, which include a radiotelephone handset, a speakerphone, and a modem. Col. 3, ll. 3-11, 50-52; Fig. 1A.
15. In order to notify the radiotelephone handset or the speakerphone that access has been granted to the device, the user is provided with a simulated dial tone. Col. 4, ll. 49-54.

PRINCIPLES OF LAW

Office personnel must rely on Appellant’s disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc). “[I]nterpreting what is *meant* by a word *in* a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’” *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1348 (Fed. Cir. 2002) (citation omitted) (internal quotation marks omitted).

On the issue of obviousness, the Supreme Court has stated that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. . . . [A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Id. at 417. “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *Id.* at 419-20.

The Examiner bears the initial burden of presenting a prima facie case of obviousness, and Appellant has the burden of presenting a rebuttal to the prima facie case. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Appellant has the burden, on appeal to the Board, to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

ANALYSIS

*Rejection of claims 1-3, 5, 8, 10-13, 15-18, and 26 under 35 U.S.C. § 103(a)
as unpatentable over Hartmaier in view of Jackson and LaPierre*

Claims 1-3, 5, 8, 10-13, and 15-18

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 1-3, 5, 8, 10-13, and 15-18. Appellant argues that Hartmaier does not teach the following claim limitations found in claim 1:

[a] telephony interface for receiving a telephone call via a first communication path[,] . . . identifying a dialed telephone number associated with the call, [and] . . . using the dialed telephone number to retrieve . . . at least one user preference . . . to route the call to at least two wireless destination telephone numbers substantially simultaneously via respective second and third communication paths

or “[a] telephony interface connecting the call to a user by connecting [the] first communication path to the second or third communication path when the second or third communication path is authenticated by the user.” App. Br. 15; Reply Br. 3-4. The Examiner has found that Hartmaier discloses a “telephony interface for receiving a telephone call via a first communication path and identifying a dialed telephone number associated with the call” and “using the dialed telephone number to retrieve at least one wireless telephone number and at least one user preference.” Ans. 4. The Examiner has found that Jackson teaches routing

the call to at least two wireless destination telephone numbers substantially simultaneously via respective second and third communication paths, and . . . connecting the call to a user by connecting the first communication path to the second or third communication path when the second or third communication path is authenticated by the user.

Ans. 4. Appellant's statements merely conclude that this finding is in error without citing evidence or further explanation. We consider such a conclusory assertion without supporting explanation or analysis particularly pointing out errors in the Examiner's reasoning to fall short of persuasively rebutting the Examiner's prima facie case of obviousness. *See Oetiker*, 977 F.2d at 1445.

Appellant additionally argues that Jackson does not teach routing the call to two numbers simultaneously or connecting the call to either the second or third communication paths when one of the paths is authenticated. App. Br. 15-16. Appellant argues that Jackson only forwards a call to the wireless phone since a pager can only receive a notification and not a call. App. Br. 16-17; Reply Br. 3. Additionally, Appellant argues that since a call cannot be answered by through the use of a pager after authentication, Jackson fails to meet the claimed limitation. However, claim 1 recites "to route the call to at least two wireless destination telephone numbers substantially simultaneously . . . [and] connecting the call to a user by connecting said first communication path to the second or third communication path" (emphasis added). Therefore, the scope of the claim only requires the ability to connect to the user through one of the wireless destination telephone numbers.

Jackson teaches that a call is routed to a wireless phone and a pager simultaneously so that a connection is immediately available by either device. FF 8. Subsequently, the user can choose to answer the call by pushing the "call" or "on" key on the wireless phone. FF 9. As a result, Jackson teaches sending a call to two wireless devices simultaneously and

connecting to the wireless phone upon an authorization action by the user. Therefore, Appellant's argument is not found to be persuasive.

Additionally, Appellant argues that Jackson does not teach the authentication process recited in claim 1. App. Br. 17. Appellant argues that the authentication process of claim 1 requires that the user answer the phone and press another key. App. Br. 17. However, claim 1 recites "connecting said first communication path to the second or third communication path when the second or third communication path is authenticated by the user." Appellant's Specification does not provide a specific definition for "authenticated." As such, we adopt the Examiner's interpretation that the call is "authenticated" by the user by accepting the call after screening it to be reasonable. Ans. 4. As noted above, when a call is placed to the wireless phone, the user can choose to answer the call by pushing the "call" or "on" key of the wireless phone. FF 9. The act of pushing the "call" or "on" key is considered the authentication process according to the Examiner's interpretation. Therefore, Appellant's argument is not found to be persuasive.

Accordingly, for the reasons stated above, we sustain the Examiner's rejection of claims 1-3, 5, 8, 10-13, and 15-18.

Claim 26

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claim 26. Claim 26 contains similar limitations to claim 1. Appellant's arguments present the same issues discussed with respect to claim 1. App. Br. 17. In addition, Appellant argues that it would not have been obvious to combine the references. App. Br. 18. Appellant's

statement merely concludes that this finding is in error without citing evidence or further explanation. We consider such a conclusory assertion without supporting explanation or analysis particularly pointing out errors in the Examiner's reasoning to fall short of persuasively rebutting the Examiner's prima facie case of obviousness. *See Oetiker*, 977 F.2d at 1445.

Appellant's additional argument that there is no motivation to combine the references is similarly not persuasive. App. Br. 18. The Supreme Court found that a teaching, suggestion, or motivation to combine the references was not required. *KSR*, 550 U.S. at 419. The Court characterized the TSM test merely as "helpful insight." *Id.* at 418. In *KSR*, the Supreme Court has stated that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416. We find that the combination of Hartmaier with Jackson and LaPierre would have yielded predictable results.

As stated above, Jackson teaches routing a call to two numbers simultaneously and connecting the call to at least one of the devices. FF 8, 9. LaPierre teaches a system wherein the telecommunication system uses wireless devices. FF 12. Hartmaier teaches a system that allows call redirection and cell forwarding. FF 3, 4. Therefore, we consider using Hartmaier's system of call redirection and forwarding with Jackson's routing system to route calls to two numbers simultaneously to LaPierre's system that uses wireless devices as nothing more than using known devices to perform known functions. As such, the combination would have been obvious.

Even if the TSM test were still required, the Examiner has provided a motivation to combine the references. Ans. 5. The Examiner stated, on

page 5 of the Answer, that the combination would “ensure that the called party can be reached” (citing Jackson) and would “provide a universal number that can be linked to multiple destinations associated with one user” (citing LaPierre). Ans. 5. Appellant merely argues that there is no motivation because the Examiner is using impermissible hindsight. App. Br. 18. Therefore, Appellant’s argument has not identified an error in the Examiner’s reasoning as to why the skilled artisan would have combined the teachings. In the absence of such argument and evidence, the Examiner’s finding that a skilled artisan would have combined the references is sufficient, as the Examiner has established that the combination is a predictable use of prior art elements according to their established functions.

Therefore, for the reasons stated above, we sustain the Examiner’s rejection of claim 26.

Rejection of claims 4, 6, 7, and 14 under 35 U.S.C. § 103(a) as unpatentable over Hartmaier in view of Jackson, LaPierre, and Chow

Appellant’s arguments have not persuaded us of error in the Examiner’s rejection of claims 4, 6, 7, and 14. Claims 4, 6, 7, and 14 ultimately depend upon claim 1 and as such include the same limitations discussed *supra* with respect to claim 1. Appellant’s arguments present the same issues discussed with respect to claim 1. App. Br. 18-19. Therefore, we sustain the Examiner’s rejection of claims 4, 6, 7, and 14 for the reasons discussed *supra* with respect to claim 1. In addition, Appellant argues that Chow does not make up for the deficiencies found in the rejection of claim 1 and it would not have been obvious to combine the references. App. Br. 19. Appellant’s statement merely concludes that this finding is in error without citing evidence or further explanation. We consider such a conclusory

assertion without supporting explanation or analysis particularly pointing out errors in the Examiner's reasoning to fall short of persuasively rebutting the Examiner's prima facie case of obviousness. *See Oetiker*, 977 F.2d at 1445.

Therefore, for the reasons stated above, we sustain the Examiner's rejection of claims 4, 6, 7, and 14.

Rejection of claim 9 under 35 U.S.C. § 103(a) as unpatentable over Hartmaier in view of Jackson, LaPierre, and Cox

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claim 9. Claim 9 ultimately depends upon claim 1 and as such includes the same limitations discussed *supra* with respect to claim 1. Appellant's arguments present the same issues discussed with respect to claim 1. App. Br. 19-20. Therefore, we sustain the Examiner's rejection of claim 9 for the reasons discussed *supra* with respect to claim 1.

Rejection of claims 19-23, 25, and 29 under 35 U.S.C. § 103(a) as unpatentable over Hartmaier in view of Jackson, LaPierre, and Karpus

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 19-23, 25, and 29. Claim 19 recites "generating and sending a simulated dial tone to the wireless telephone." Appellant argues that none of the references teach the limitation found in claim 19 since Karpus teaches sending the simulated dial tone to a telephone accessory and not the telephone itself. App. Br. 21-23; Reply Br. 4-5. Appellant argues that the Examiner's interpretation of the term "wireless telephone" is unreasonably broad and inconsistent with an interpretation of one of ordinary skill in the art. Reply Br. 4-5. Appellant points to the Specification to contend that a "wireless telephone" is a cellular device that

does not use a dial tone. Reply Br. 4. However, we decline to adopt Appellant's narrow construction of "wireless telephone" to include only cellular devices since that would require importing limitations that are not recited in the claims from the Specification. In addition, Appellant has not provided any evidence that in light of the Specification the term "wireless telephone" would be understood by those skilled in the art to exclude Karpus's wireless handset. Therefore, we find the Examiner's interpretation of "wireless telephone" as being a wireless handset to be sufficient. As a result, Karpus does teach the claim limitation of claim 19.

Karpus discloses a system wherein an access grant is communicated to the user of a wireless radiotelephone handset by providing a simulated dial tone to the wireless radiotelephone handset. FF 15. This is equivalent to sending a simulated dial tone to a wireless telephone, as claimed. As such, we sustain the Examiner's rejection of claims 19-23, 25, and 29.

Rejection of claim 24 under 35 U.S.C. § 103(a) as unpatentable over Hartmaier in view of Jackson, LaPierre, Karpus, and Chow

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claim 24. Claim 24 ultimately depends upon claim 19 and as such includes the same limitations discussed *supra* with respect to claim 19. Appellant's arguments present the same issues discussed with respect to claim 19. App. Br. 23. Therefore, we sustain the Examiner's rejection of claim 24 for the reasons discussed *supra* with respect to claim 19.

CONCLUSIONS OF LAW

Appellant has not shown that the Examiner erred in finding that Hartmaier in view of Jackson and LaPierre teach the claim limitations set forth in claim 1.

Appellant has not shown that the Examiner erred in combining Hartmaier with Jackson and LaPierre.

Appellant has not shown that the Examiner erred in combining Chow with Hartmaier, Jackson, and LaPierre.

Appellant has not shown that the Examiner erred in finding that Karpus teaches generating and sending a simulated dial tone to the wireless telephone and providing access to an enterprise telecommunication network that consists solely of wireless devices.

SUMMARY

The decision of the Examiner to reject claims 1-26 and 29 is affirmed.

No period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
WASHINGTON, DC 20006-5403